

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

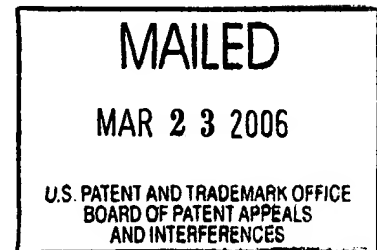
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRIAN FEENEY and CHRIS WALDECK

Appeal No. 2006-0911
Application No. 09/248,595

ON BRIEF



Before FRANKFORT, OWENS, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 3, which is the only claim pending in this application. This is the second appeal in this application. In a decision mailed January 27, 2003 (Appeal No. 2002-0979), the examiner's rejection of claims 1-6, 8-12, 17 and 18 under 35 U.S.C. § 103 was reversed, a new rejection of claim 11 under 35 U.S.C. § 102 was entered and the application was remanded to the examiner for consideration of a written description issue. Subsequent to that decision, appellants cancelled all of the claims except claim 3.

BACKGROUND

The appellants' invention relates to a game ball having increased resistance to moisture absorption. Claim 3 is the only claim pending in this application and reads as follows:

3. A game ball having increased resistance to moisture absorption comprising a natural leather cover disposed over a lining, the leather of said cover having increased water resistance properties distributed throughout during a tanning process, wherein when said ball is subjected to six 45 minute cycles of a rain test and said ball is permitted to dry at approximately 70°F for 24 hours between cycles, said ball contains an amount of water at the conclusion of each said rain test cycle as expressed as a ratio of the weight of the ball with absorbed water to the weight of the dry ball, an average per cycle ratio at the conclusion of said six rain test cycles being a maximum of 1.20:1.

Claim 3 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that appellants had possession of the claimed invention. In other words, claim 3 stands rejected for failure of the specification to comply with the enablement requirement and the written description or possession requirement.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed April 2, 2004) and answer (mailed January 25, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief¹ (filed November 10, 2004) for the appellants' arguments thereagainst.

OPINION

In rejecting claim 3 under 35 U.S.C. § 112, first paragraph, the examiner expresses two concerns. The first is that appellants have failed to disclose the particular tanning process which was used to produce the increased water resistance properties for the full range of weight ratios which is critical or essential to the practice of the invention (answer, page 4). The second concern is that, according to the examiner, the application as filed does not provide support for a game ball without a bladder. In the final rejection, the examiner concluded that the first problem resulted in non-compliance with the written description requirement while the second resulted in non-compliance with the enablement requirement. In the answer, however, the examiner concluded that the first problem amounted to non-compliance with the enablement requirement while the second amounted to non-compliance with the written

¹ The drawing objection issue raised by appellants on page 7 of the brief is not within the jurisdiction of the Board, being reviewable by petition to under 37 CFR § 1.181. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967).

description requirement. In any event, for the reasons which follow, we conclude that the issues raised by the examiner amount to neither an enablement problem nor a written description problem.

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellants' disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the

invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

As for the first issue, namely, appellants' failure to describe in the specification the particular tanning process used to achieve the recited increased water resistance properties, we first observe that claim 3 is not directed to a process for making a game ball and does not recite a step of tanning the game ball to achieve the recited properties. Rather, claim 3 is directed to a game ball having increased moisture resistance comprising a leather cover having increased water resistance properties distributed throughout during a tanning process.

Appellants' specification informs us, on page 10, that "[l]eather meeting the requirements of the present invention may be commercially obtained from a leather supplier such as Pittard's Inc., Leeds, England or Bali Leathers, Inc., Johnston, New York" and gives specific examples of leathers (Pittard's WR2000TC and WR100) which meet the requirements of appellants' invention. Appellants' specification (page 11) goes on to disclose that, if the game ball of the present invention is exposed to six cycles of the rain test of 45 minute duration and the ball is allowed to dry at about 70°F

for 24 hours between cycles, the ball will maintain an absorption ratio in the range of 1.01:1 to 1.2:1.

One of ordinary skill in the art would understand from the disclosures noted above that game balls comprising leather covers made with the Pittard's WR2000TC and WR100 leathers referred to on page 10 of appellants' specification would have sufficient water resistance that the ball would maintain an absorption ratio of no more than 1.20:1 and thus would have an average per cycle ratio at the conclusion of the six rain test cycles of no more than 1.20:1. Accordingly, one of ordinary skill in the art would have known how to make and use the invention recited in claim 3 without undue experimentation by, for example, obtaining the leather cover material having a Pittard's WR2000TC or WR100 designation. As for the written description requirement, the above-noted disclosures in appellants' specification would certainly have conveyed that appellants were in possession, at the time appellants' application was filed, of a game ball comprising a tanned natural leather having the recited water resistance properties.

We turn next to the issue raised by the examiner that claim 3 does not recite a bladder and thus encompasses both game balls having a bladder and game balls without a bladder. The paragraph bridging pages 10 and 11 of appellants' specification addresses the performance of the entire game ball in the face of wet conditions and discusses a game ball "of the present invention" having a leather cover and a lining meeting the absorption ratio limitation recited in claim 3 after a single 45-minute rain

test cycle. The next paragraph on page 11 of the specification states that a game ball "of the present invention" will meet the recited absorption ratio after six rain test cycles.

One of ordinary skill in the art would understand from these two paragraphs that a game ball having a leather cover made of one of the leathers designated on page 10 of the specification and a lining, either with or without a bladder, would be expected to meet the absorption ratio recited in claim 3. These paragraphs give no indication that the inclusion of a bladder is critical to achieving the necessary moisture resistance properties.

Moreover, appellants' specification states on page 4 that, while typically balls featuring a construction including a lining having water resistant properties over which a leather cover is disposed having water resistant properties include an air bladder, "balls of other types of construction (including those made with central cores or centers) may also benefit from use of this invention." This certainly very directly conveys that game balls having a leather cover and a lining, either with or without bladders, were contemplated as falling within the scope of appellants' invention. Page 4 of appellants' specification also mentions that the lining, in addition to providing structure and reinforcement for the cover of the ball, also provides for improved water resistance in the finished ball. The specification makes no such association with the bladder. Accordingly, one of ordinary skill in the art reading this disclosure would have no reason to believe that the bladder is essential for achieving the desired moisture resistance

properties and would have every expectation that a game ball comprising a leather cover meeting the requirements of the invention and a lining, either with or without a bladder in addition thereto, would meet the absorption ratio requirements set forth on pages 10 and 11 of the specification.

In light of the foregoing, we cannot sustain the examiner's rejections of claim 3 under 35 U.S.C. § 112, first paragraph, either as lacking enablement or as lacking written description support.

To summarize, the decision of the examiner to reject claim 3 under 35 U.S.C. § 112, first paragraph, is REVERSED.

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2006-0911
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Page 10

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